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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,015	07/20/2001	Kazuhiro Sugawara	35.C15592	9096

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EXAMINER	
ARTHUR JEANGLAUDE, GERTRUDE	

ART UNIT	PAPER NUMBER
2144	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/909,015	SUGAWARA, KAZUHIRO	
	Examiner	Art Unit	
	Gertrude Arthur-Jeanglaude	2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-8, 16-17, 20, 22, are rejected under 35 U.S.C. 102(b) as being anticipated by Chalmers et al. (WO 99/14909).

As to claims 7, 16, Chalmers et al. discloses a communicating apparatus comprising obtaining means for obtaining size information of each of a plurality of E-mails stored in a mail box provided on an E-mail server (See Fig.3, # 303, 304, 321, 330; Fig.4); selecting means (page 4, line 20) for selecting the receivable E-mail on the basis of the size information obtained by the obtaining means; and receiving means (page 4, line 15) for receiving the E-mail selected by the selecting means from the E-mail server; and a control unit, adapted to control the receiving unit so as not to receive an E-mail which was not selected by the selection unit from the e-mail server (See abstract; Fig.4).

As to claims 8, 17 Chalmers et al. disclose in Figs.3-4 the selecting means compares a maximum value of a size of one E-mail which has previously been stored with the size information obtained by the obtaining means, thereby discriminating whether the e-mail is receivable or not.

As to claim 20, Chalmers et al. disclose a computer program (See page 15, lines 19-30) which is executed by a computer of an information processing apparatus having a communication function comprising obtaining means for obtaining size information of each of a plurality of E-mails stored in a mail box provided on an E-mail server (See Fig.3, # 303, 304, 321, 330; Fig.4); selecting means for selecting the receivable E-mail on the basis of the size information obtained by the obtaining means; and receiving means for receiving the E-mail selected by the selecting means from the E-mail server (See abstract; Fig.4).

As to claim 22, Chalmers et al. disclose a computer readable memory medium 6 that stores a computer program.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 9-15, 18-19, 21,are rejected under 35 U.S.C. 103(a) as being unpatentable over Chalmers et al. (WO 99/14909) in view of Geiger et al. (US 6073142).

As to claims 1, 10, Chalmers et al. disclose a communicating apparatus comprising receiving means for receiving E-mails stored in a mail box (5) as shown in Fig.1 provided on an E-mail server; obtaining means for obtaining a size of an E-mail

stored in the mail box; memory means (6) for storing a maximum value of the size of one E-mail which is received by the receiving means; discriminating means (considered as message filter 2 in Fig. 1) for comparing the E- mail obtained by the obtaining means with the maximum value, thereby discriminating whether the E-mail is receivable or not; (also see Fig. 5; # 520, 530, 531, 540, 541) and obviously a control means for sending an instruction for deleting (selecting part of a message) the E-mail which was determined to be unreceivable by the discriminating means to the E-mail server and storing the fact that the E-mail has been deleted into a communication history (See abstract). Though Chalmers et al. disclose a discriminating means (message filter) capable of processing the total size of a message; and comparing the size of the E-mail (See page 6, lines 5-25); it does not specifically disclose deleting the E-mail that is unreceivable. In an analogous art, Geiger et al. disclose a communicating apparatus wherein the size of the E-mail is compared and deleting E-mail (See col.3, lines 3, lines 23-51). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Chalmers et al. with that of Geiger et al. by having a size of an E-mail and delete the email that is unreceivable in order to better direct E-mails.

As to claims 2, 4, 11-12 Chalmers et al. disclose as shown in Fig. 2 a header information of the E-mail whereas it is considered that the E-mail was determined to be unreceivable and receivable by the discriminating means (as the message filter may select the whole or a part of the message and arrange for the storage of the selected part in a store 6) (See abstract).

As to claims 3, 5, 6, 13-15, Chalmers et al. disclose the discriminating means as discussed and a stored means 6 wherein it would have been obvious to store the size information of the e-mail which was determined to be unreceivable by the discriminating means into the communication history. Also Chalmers disclose a mailbox 5 as shown in Fig. 1 for storing e-mails. Moreover, Chalmers et al. disclose the control means as discussed that allows recording means (storing) to record the E-mail (See page 3, lines 19-25).

As to claims 9, 18 Chalmers et al. disclose the email but not specifically disclose deletion instructing means for sending an instruction for deleting the e-mails. In an analogous art, Geiger et al. disclose the deleting of e-mails (See col.3, lines 3, lines 23-51). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Chalmers et al. with that of Geiger et al. by having a size of an E-mail and delete the email that is unreceivable in order to better direct E-mails.

As to claim 19, Chalmers et al. disclose a computer program (See page 15, lines 19-30) which is executed by a computer of an information processing apparatus having a communication function comprising receiving means for receiving E-mails stored in a mail box (5) as shown in Fig.1 provided on an E-mail server; obtaining means for obtaining a size of an E-mail stored in the mail box; memory means (6) for storing a maximum value of the size of one E-mail which is received by the receiving means; discriminating means (considered as message filter 2 in Fig. 1) for comparing the E-mail obtained by the obtaining means with the maximum value, thereby discriminating

whether the E-mail is receivable or not; (also see Fig. 5; # 520, 530, 531, 540, 541) and obviously a control means for sending an instruction for deleting (selecting part of a message) the E-mail which was determined to be unreceivable by the discriminating means to the E-mail server and storing the fact that the E-mail has been deleted into a communication history (See abstract). Though Chalmers et al. disclose a discriminating means (message filter) capable of processing the total size of a message; and comparing the size of the E-mail (See page 6, lines 5-25); it does not specifically disclose deleting the E-mail that is unreceivable. In an analogous art, Geiger et al. disclose a communicating apparatus wherein the size of the E-mail is compared and deleting E-mail (See col.3, lines 3, lines 23-51). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Chalmers et al. with that of Geiger et al. by having a size of an E-mail and delete the email that is unreceivable in order to better direct E-mails.

As to claim 21, Chalmers et al. disclose a computer readable memory medium 6 that stores s computer program.

Response to Arguments

Applicant's arguments filed 1/21/05 have been fully considered but they are not persuasive.

REMARKS

Applicant's representative in his arguments states that Applicant has found nothing in Chalmers et al. that would teach or suggest a control unit controlling the

receiving unit so as not to receive an E-mail discriminated by the discriminating unit as being not receivable, sending an instruction to E-mail server to delete the E-mail, and storing into a communication history that the E-mail has been deleted. However the prior art of Chalmers et al. has to obviously have a control system to control transmission and reception and also control e-mail messages by selecting part of the messages and wherein the non-selected is considered as not receivable (See abstract). However, Chalmers et al. does not specifically disclose deleting the e-mail that is not receivable. On the other hand, Geiger et al. disclose a system and method and various products provide for automatic deferral and review of e-mail messages wherein it discloses in Fig. 4A # 422 delete message wherein action was taking on handling e-mail messages before delivering the email to a client. It is therefore considered that the e-mail message was not receivable and was deleted. Also (see abstract) where a gatekeeper can review the gated messages and delete the messages. Geiger et al. also consider the size of the e-mail (See col. 3, lines 39-51). Applicant's representative argues that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's own disclosure (M.P.E.P. 2143). Further, if the proposed modification or combination of the prior art would change the principle of the operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F .2d 810, 123 USPQ 349 (CCPA 1959).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the rejection is sustained.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Woltz et al. (U.S. Patent No. 6,216,165) disclose an E-mail paging system and method.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gertrude Arthur-Jeanglaude whose telephone number is (571) 272-6954. The examiner can normally be reached on Monday-Friday from 8:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wiley David can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gertrude A. Jeanglaude

GERTRUDE A. JEANGLAUDE
PRIMARY EXAMINER

GAJ

GAJ

May 16, 2005